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IN THE UNITED STATES PATENT AND TRADEMARK OFFICEApplicants: Donald R. Huffman,
et al.

Examiner: S. Kalinchak

Serial No.: 580,246

Art Unit: 1103

Filed: October 22, 1991

Docket: 7913Z

For: NEW FORM OF CARBON

Dated: November 2, 1993

Hon. Commissioner of Patents
and Trademarks
Washington, DC 20231

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LETTER

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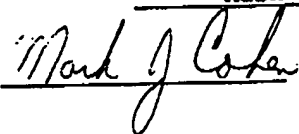
Sir:

Applicants wish to bring to the attention of the Examiner that U.S. Patent No. 5,114,477 to Mort, et al. ("Mort, et al.") issued on May 19, 1992, and as such, applicants are time barred from presenting Claim 186, which is the same as or substantially the same as Claim 21 of Mort, et al., pursuant to 35 U.S.C. §135(b).¹ Nevertheless, this Communication should not be construed as a Response to the Office Action dated September 22, 1993, which applicants reserve the full end of the term now set, and following a Decision on Petition.²

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Mark J. Cohen



November 2, 1993

¹ Applicants refer to §135(b) and its period of repose, at Page 9 of the pending Petition Footnote 8 but had not specifically brought this point to the attention of the Examiner for initial decision, now accomplished for the sake of proper administrative review.

² In a Communication from Edward Kubasiewicz, Director of the Patent Examining Group 1100, dated October 21, 1993, applicants were granted until December 22, 1993, to respond to the outstanding Official Action.

The present application is directed to product claims. The following claims are representative and have been indicated to be allowed by the United States Patent and Trademark Office:

- 85. Substantially pure solid C₆₀.
- 90. Substantially pure solid C₇₀.
- 94. Substantially pure crystalline C₆₀.
- 95. Substantially pure crystalline C₇₀.

The present application does not claim any ink or pigment compositions. Indeed, there is no claim whatsoever to any use at all. Nor were any such claims even presented, and applicants have made no oath to such an invention.

However, in the Communications dated August 24, 1993 and September 2, 1993, the United States Patent and Trademark Office imposed a requirement pursuant to 37 C.F.R. §1.605 that applicants present a claim to an ink composition for purposes of initiating an interference pursuant to 35 U.S.C. §135(a) with Mort, et al. More specifically, the United States Patent and Trademark Office requested that the applicants copy Claim 21 of Mort, et al. as follows:

186. An ink composition containing fullerenes or mixtures of fullerenes.

The claim to be presented was modified in an Official Communication dated September 22, 1993 to read:

186. A pigment composition comprising C₆₀, C₇₀, or a mixture thereof.

Nevertheless, this Communication indicated that this modified Claim 186 corresponded to Claim 21 of Mort, et al. and was to be presented by applicants under 35 U.S.C. §135(a) for the purposes of an interference.

Mort, et al. issued on May 19, 1992, and by the time the United States Patent and Trademark Office indicated it

wished applicants to copy the claim, more than one year had elapsed since the issuance of Mort, et al. Pursuant to 35 U.S.C. §135(b), applicants are time barred from presenting this claim.

35 U.S.C. §135(b) reads as follows:

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to the year from the date on which the patent is granted.

Essentially, this section operates at a statute of limitations in copying the claims for the purposes of instigating interferences. In re Sasse, 629 F.2d 675, 680, 207 USPQ 107, 110 (CCPA 1980). "The statute converted what had been an equitable doctrine ...into a statutory requirement, like the statutory time bar of §102(b), the application of which is mandatory." Corbett v. Chisholm, 568 F.2d 759, 765, 196 USPQ 337, 342-343 (CCPA 1977). The Congressional intent underlined in §135(b) is to leave a patentee "whose right might otherwise be challenged, undisturbed after a reasonable period, fixed at one year." Switzer v. Sockman, 333 F.2d 935, 939, 142 USPQ 226, 229 (CCPA 1964), cert. denied, 380 U.S. 906, 144 USPQ 781 (1965).

There can be no dispute that Claim 186 is the same as or for the same or substantially the same subject matter as the claim in Mort, et al., and that if presented, this claim would place the present application in interference with Mort, et al. There is also no question that Claim 186 in the form suggested by the Patent Office is not present in the application at this point. However, the United States Patent and Trademark Office is requesting the applicants to present the claims more than one year after Mort, et al. issued, which as indicated below, is violative of the statute and contrary to the congressional intent.

The issue to be decided is whether the claim proposed by the United States Patent and Trademark Office is the same as or for the same or substantially the same subject matter as the claims in the present application. Parks v. Fine, 773 F.2d 1577, 227 USPQ 432 (Fed. Cir. 1985), modified, 783 F.2d 1036, 228 USPQ 677 (Fed. Cir. 1986). The inquiry is not whether the application has support for this suggested claim. Corbett v. Chisholm, 568 F.2d at 766, 196 USPQ at 343. The question is whether the claims in the application inherently contain the limitation in Mort, et al. and whether this limitation is material. Parks v. Fine, 773 F.2d at 1580, 227 USPQ at 434.

As discussed hereinabove, the limitation of Claim 186 is not contained in the present application, and were never presented therein. Moreover, the limitations in the suggested claim are material. The suggested claim as well as Claim 21 in Mort, et al. call for a specific utility; i.e., the suggested claim and Claim 21 of Mort, et al. are use claims. On the other hand, the present claims are product claims. They do not recite any ink or paint compositions whatsoever. As such, there is no interference-in-fact as between the existing product claims and the use claims.

The United States Patent and Trademark Office cannot dispute this conclusion for several reasons. First, if the limitations were immaterial, then the United States Patent and Trademark Office would declare the interference, sua sponte, without requiring applicants to present the suggested claims. Under the new interference rules, if two inventions are patentably indistinct, they may be placed in an interference. Upon that basis, without more, the United States Patent and Trademark Office could declare an interference between the present application and Mort, et al. However, it chose not to

do so, indicating a belief on its part that there is no interference-in-fact between the claims in Mort, et al. and the existing claims in the present application at this point and during the one year period mandated by 35 U.S.C. §135(b).

Secondly, in the Communication dated August 24, 1993, the Patent Office did not refer solely to the existing claims for the support of proposed Claim 186. Specifically, the Patent Office points to disclosures in the specification on Page 15, lines 30-32 and Page 5, line 30 to Page 6, line 14 of the specification for support of proposed Claim 186. If support for the proposed claim use were found solely in the existing claims, then the United States Patent and Trademark Office would not have to resort to passages in the text of the specification for its support.

Thirdly, the file wrapper of Mort, et al. clearly establishes that the limitations in Claim 21 are material. In the patent, Mort, et al. acknowledge the contribution of Huffman and Kratschmer for the preparation of buckminsterfullerenes and other fullerenes from the vaporization of graphite and the isolation and characterization thereof and attribute this discovery to Huffman and Kratschmer. Furthermore, Mort, et al. cited various articles including, inter alia, an article by Kratschmer, et al. in Nature, 1990, 347, 354-358 and Baum, et al. in Chemical Engineering News, October 29, 1990, pp. 22-25, describing the preparation and characterization of fullerenes, such as C₆₀, by Huffman and Kratschmer. These articles referred to hereinabove were published prior to the filing of Mort, et al. and constitutes valid prior art thereto. These references were clearly reviewed and considered by the United States Patent and Trademark Office. Yet, in spite of the admissions by Mort, et al. and the teachings in the prior art references, the United

States Patent and Trademark Office made the following statement in the reasons for allowance attached to the Notice of Allowability:

The following is an Examiner's Statement of Reasons for Allowance: This application teaches an ink composition comprising an aqueous or organic liquid vehicle, and as a colorant a fullerene or mixture of fullerenes. The references cited show the discovery and development of fullerenes but fail to teach their use in ink compositions. Accordingly, the references are not seen to teach or fairly suggest the claimed ink composition. (Emphasis added).

In other words, the United States Patent and Trademark Office made a determination that the subject matter relating to the products of fullerenes is patentably distinct from the ink composition recited in Claim 21 of Mort, et al.

Inasmuch as the subject matter of the present application is directed to the products of fullerenes, the subject matter of the present invention is therefore patentably distinct from the subject matter of Mort, et al. recited in Claim 21 directed to an ink composition, and consequently is patentably distinct from Claim 186 corresponding thereto.

Inasmuch as the subject matter of the proposed claim was not present in the present application to date, and inasmuch as the subject matter of Claim 186 is presented for the first time³ more than one year after the issuance of

³ The present statute is a codification of R.S. 4903 which was amended in 1939 to include the following paragraph: No amendment for the first time presenting or asserting a claim which is the same as, or for substantially the same subject matter as, a claim of an issued patent may be made in any application unless such amendment is filed within one year from the date on which said patent was granted.

⁸ Corbett v. Chisholm, 568 F.2d 759, 762, 196 USPQ 337, 342 (CCPA 1977) (Emphasis in original). The court also observed that this paragraph was amended to its present form in 1952 as (continued...)

Mort, et al., any attempt to present Claim 186 at this time violates the statute and "disturbs" the patentee after the proscribed period of repose of one year has expired.

The requirements of 35 U.S.C. §135(b) are mandatory and are equally applicable to the United States Patent and Trademark Office. Googen v. Mahdjuri, 209 USPQ 667 (Comm'r Patents and Trdmks, 1980). However, in the present case, the United States Patent and Trademark Office is apparently seeking to effectively (and unilaterally) waive the requirements of 35 U.S.C. §135(b) by requiring that applicants present a claim outside the critical period that is the same or substantially the same as the claim in an issued patent. The United States Patent and Trademark Office has no authority to make such a request, and its failure to apply the mandatory requirements of the statute is clearly erroneous.

If the United States Patent and Trademark Office believes that the subject matter in Mort, et al. is patentably indistinct from the subject matter in the present case, then the United States Patent and Trademark Office has other means at its indisposal to determine priority of invention, e.g., it may declare an interference pursuant to 37 C.F.R. §1.606 sua sponte.⁴ Nevertheless, applicants respectfully submit that

³(...continued)
the second paragraph of §135, later designated as paragraph (b), and that no substantial change was intended by the changes in language. Therefore, the legislative history further supports the conclusion that the presentation of Claim 186 for the first time would be violating the meaning of the statute.

⁴ Such a procedure is unnecessary in the present circumstances in any event. Mort, et al. have acknowledged the status of Huffman and Kratschmer as prior art --indeed there was no source for the material subject of the use until after the discovery by Huffman and Kratschmer so the interference is an unnecessary vehicle to an obvious result and has no apparent purpose except to burden the parties.

The more politic solution is to allow the present application to issue, providing a 35 U.S.C. §102(e) reference,
(continued...)

the provisions of 35 U.S.C. §135(b) prevent them from presenting Claim 186 in the present application.

Respectfully submitted,

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MJC:ds

⁴(...continued)
and thereafter to seek, sua sponte, reexamination, pursuant to 35 U.S.C. §303 and 37 C.F.R. §1.520, of such use cases.